

## REMARKS/ARGUMENTS

As a result of the Amendment, claims 1-6 are under active consideration in the subject patent application.

In the Official Action, the Examiner has:

- (1) rejected claims 2-3 under 35 U.S.C. §112, first paragraph;
- (2) rejected claims 1-4 under 35 U.S.C. §112, second paragraph;
- (3) rejected claims 1 and 4 as being allegedly anticipated by U.S. Patent No. 6,387,220, issued to Mohrsen et al., under 35 U.S.C. §102(b);
- (4) rejected claims 1-3 under 35 U.S.C. § 103(a) in view of the proposed combination of U.S. Patent No. 3,765,757, issued to Weigl, and German Patent No. DE 4018950, issued to Kock et al.; and
- (5) identified prior art made of record and not relied upon but considered pertinent to Applicant's disclosure.

With regard to Items 1 and 2, Applicant has amended claims 1-4 and added new claims 5 and 6, so as to more particularly point out and distinctly claim the subject of the invention. The issues raised with respect to 35 U.S.C. §112, first paragraph have been corrected by amendments to claims 1-4. As to the 35 U.S.C. §112, first paragraph issues raised relative to claims 2 and 3, Applicant requests reconsideration and respectfully submits that these features are disclosed throughout the drawings and in the specification at least at the bottom of page 3 and the top of page 4 of the translation. In particular, Applicant discloses that under the upper run of the conveyor (7) are located either magnets or suction nozzles (6) which apply an external force to thereby frictionally connect intermittently to the thin strip to the surface of the table. One of

ordinary skill would be fully aware of the structures and construction of such an arrangement upon a review of this portion of the specification in light of the drawings. New claims 5 and 6 have been added to make these patentable features of the invention more apparent.

Accordingly, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. §112, first and second paragraph.

With regard to Item 3, Applicant respectfully traverses the rejection of claims 1 and 4 as allegedly being anticipated by U.S. Patent No. 6,387,220, issued to Mohrsen et al., and request reconsideration for the following reasons. Applicant provides a device that is particularly suitable for transferring or threading thin strips of material into the head ends of a variety of machines or treatment stations. Applicant's device includes a transfer table that has a width that is at least equal to the width of the thin strip, with a surface that defines a slot along the direction of movement of the thin strip. This slot has a width that is less than a minimum width of the thin strip, but is sized so as to accept an upper belt of a conveyor that is circulating in the direction of movement of the thin strip. This upper belt is arranged so as to be swivelled out across the surface. Advantageously, an external force, e.g., a magnetic field or a vacuum, acts through the surface of the table to cause the thin strip to be intermittently frictionally engaged with that surface.

Anticipation under 35 U.S.C. §102 requires that each and every element of the invention defined in the claim be met in a single prior art reference. Those elements must either be inherent or disclosed expressly, and must be arranged as described in

the claim. See, Diversitech Corporation v. Century Steps, Inc., 850 F. 2d 675, 7 U.S.P.Q. 2d 1315 (Fed. Circuit 1988), Constant v. Advanced Micro-Devices, Inc., 848 F. 2d 1560, 7 U.S.P.Q. 2d 1057 (Fed. Circuit 1988), and Richardson v. Suzuki Motor Company, 868 F. 2d 1226, 9 U.S.P.Q. 2d 913 (Fed. Circuit 1989). The Mohrsen patent reference fails to meet this requirement since Applicants' invention, as claimed, is not expressly or inherently disclosed within the four corners of the reference. In particular, Mohrsen fails to teach or suggest (i) the use of an external force, such as a magnetic field, to intermittently frictionally maintain a thin strip on a surface during a strip transfer activity, or (ii) supporting a thin strip of material on a transfer table having a slot that accepts a belt. In fact the words "magnet," "field," "table" and "slot" could not be located within the four corners of the Mohrsen reference by means of computer-aided key word search of that document.

Instead, Mohrsen teaches an apparatus for transferring at least a portion of a running web, including a belt conveyor that includes at least two pulleys, in which at least one is a driven pulley, a suction box coupled to a vacuum source, and an air-pervious endless conveyor belt tensioned over the at least two pulleys. Unlike Applicant's device, Mohrsen's suction box is located within a loop of conveyor belt and is positioned to create a vacuum sufficient to draw a portion of the running web onto the endless conveyor belt and that acts through the endless conveyor, not through an opening in the surface of a transfer table.

Accordingly, it cannot be said that the Mohrsen reference anticipates the subject matter of claims 1-6 under 35 U.S.C. §102.

With regard to Item 4, Applicant respectfully submits that claims 1-3, 5, and 6, are patentable over the proposed combined teachings of Weigl and Kock, and requests reconsideration for the following reasons. Weigl discloses a processing station with a film coating station for depositing a film of dyed thermoplastic onto a thin sheet of material (Weigl 3:29-45). The thin sheet of material is transported by placing it in contact with a conductive mat that has a plurality of electrically conductive contact members that extend from the mat to secure the thin sheet material. The Examiner has looked to Fig. 4 in support of the proposed combination. This is a clear error. Fig. 4 illustrates a schematic view of an electrostatic reproduction apparatus where a sheet of dielectric material is supplied in the form of a continuous strip (Weigl 5:10-25). Contrary to the Examiner's assertions, Fig. 4 does not include a transfer table at all, let alone one that has a width that is at least equal to the width of a thin strip, and a surface that defines a slot along the direction of movement of the thin strip. Moreover, Weigl appears to rely upon electrostatic charge to maintain the sheet in place and not a vacuum or magnetic field acting through an opening in the surface of a table.

The Examiner relies upon the Kock reference for teachings of a guiding assembly that can be pivoted over the surface of a transfer table and to which a band can be connected by external force. However, Kock utterly fails to teach or suggest a vacuum or magnetic field acting through an opening in the surface of a table. The examiner is reminded that in order for a prima facie case of obviousness to be established, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142 [emphasis added]. When the Weigl and Kock references are combined and taken as a whole, they suggest an electrostatic reproduction apparatus that provides for the transport of thin material by securing that material to a continuous conveyor belt via electrostatic charge, and that includes a guiding assembly that has an upper run that can be pivoted over the surface of the continuous conveyor to avoid manual intervention.

The combination of Weigl and Kock fails to teach or suggest a device that is particularly suitable for transferring or threading thin strips of material into the head ends of a variety of machines or treatment stations. The combined teachings of Weigl and Kock do not teach or suggest a transfer table at all, let alone a table that has a width that is at least equal to the width of the thin strip, with a surface that defines a slot along the direction of movement of the thin strip. The combined teachings of Weigl and Kock also do not teach or suggest that this slot have a width that is less than a minimum width of the thin strip, but is sized so as to accept an upper belt of a conveyor that is circulating in the direction of movement of the thin strip. Although Kock may suggest that an upper belt be arranged so as to be swivelled out across the surface, Kock alone or in combination with Weigl fails to teach or suggest in any way an external force, e.g., a magnetic field or a vacuum, that acts through the surface of the table to cause a thin strip of material to be intermittently frictionally engaged with that surface.

In summary, when the teachings of these references are combined, and taken as a whole, there is simply no suggestion or motivating disclosure provided to direct one of ordinary skill to the claimed structure, absent impermissible hindsight on the part of the Examiner. It is a clear error to reject a claimed invention as an obvious combination of the teachings of two prior art references when the prior art provided no teaching, suggestion, or incentive supporting the combination. In re Bond, 910 F. 2d 831, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990).

Independent claims 1, 5, and 6 are allowable over the proposed combination of Weigl with Kock. Dependent claims 2-4 are all allowable, at least through dependency from allowable claim 1. Reconsideration and withdrawal of the rejection of claims 1-3, under 35 U.S.C. § 103 are therefore respectfully requested.

With regard to Item 5, Applicants have considered the prior art references identified by the Examiner as pertinent and determined that none of them, taken alone, or in any valid combination with the Mohrsen, Weigl and Kock references anticipates or renders obvious the present invention.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If a telephone conference would be of assistance in advancing prosecution of the above-identified application, Applicants' undersigned Attorney invites the Examiner to telephone him at **215-979-1255**.

Respectfully submitted,

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